

surfactants in O/W emulsions can be problematic because emulsions containing surfactants can require specific, limited manufacturing conditions and/or cause skin irritation upon application. Thus, this unique combination of ingredients in O/W emulsions addresses, among other things, such problems associated with previous surfactant-containing emulsions. As such, the present invention is novel and represents an advance in the art deserving of patent protection.

In view of this background, the rejections made in the outstanding Office Action will now be addressed in turn.

#### **REJECTION UNDER 35 U.S.C. §112**

The Office Action rejected claims 20-29 and 33-38 under 35 U.S.C. §112, first paragraph, as containing subject matter not described in the specification. In view of the following comments, Applicants respectfully traverse this rejection and request reconsideration thereof.

The §112 rejection is based upon the assertion that the specification does not describe an O/W emulsion that may contain a surfactant. This rejection was first made in the Office Action dated December 18, 2001. In response to the December 18 rejection, Applicants pointed out (in an Amendment dated April 3, 2002) that support for claims 20-29 and 33-38 is found, *inter alia*, at page 1, lines 1-7 of the present specification. In the most recent Office Action, it was stated that this text did not provide persuasive support for claims 20-29 and 33-38 because it was directed to “background information provided on the general state of emulsions.” However, the Office Action’s interpretation of this text is incorrect. Page 1, lines 1-7 read as follows (emphasis added):

The invention relates to a stable oil-in-water (O/W) emulsion comprising oil globules with an average size of less than 20 microns and containing at least 15% of oily phase and at least one copolymer of a fatty-chain carboxylic acid. The invention also relates to the process for preparing such an emulsion and to its use in cosmetics and/or dermatology.

Clearly, this text relates to the claimed invention, not background information. Because it relates to the claimed invention and because it does not exclude the presence of a surfactant, it provides support for claims 20-29 and 33-38.

In view of the above, Applicants respectfully submit that the §112 rejection is improper and should be withdrawn.

#### **REJECTION UNDER 35 U.S.C. §103**

The Office Action rejected claims 1-10, 15-29 and 34-38 under 35 U.S.C. §103 as obvious over JP 09255529 (“JP ‘529”) in combination with U.S. patent 5,326,484 (“Nakashima”). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

No motivation exists to combine JP ‘529 and Nakashima with the expectation that a stable emulsion containing monodispersed globules would be obtained. As noted in the Office Action, JP ‘529 does not teach or suggest monodispersed globules. Moreover, JP ‘529 teaches that a substantial amount (at least 0.5%) of solid oil (that is, oil that is in a solid state at room temperature) must be present. (See, for example, page 10 at [0014] and page 12 at [0021] of the English translation of JP ‘529).

To compensate for JP ‘529's deficiencies, the Office Action relies on Nakashima, asserting that it would have been obvious to use Nakashima's methods to monodisperse JP ‘529's emulsions with the expectation that a more stable emulsion could be obtained without the use of surfactants. However, there is no indication that JP ‘529's oil phases containing

substantial amounts of solid oil could be subjected to Nakashima's methods or that, if subjected to such methods, JP '529's O/W emulsions would emerge stable and monodispersed. This is particularly true in view of the fact that Nakashima is virtually silent regarding what oils can be used in his methods. The only teaching Nakashima provides in this regard is in his examples directed to O/W emulsions where the oil phase is a non-solid oil, kerosene. (See, examples I and II directed to O/W emulsions at col. 9, line 50 and col. 11, line 11, respectively).

Given such a minimal disclosure regarding acceptable oils for use in his methods, Nakashima cannot be said to teach or suggest that his methods would have been obvious to use for any oil phase with the expectation that acceptable, stable, monodispersed compositions would be obtained, particularly oil phases containing a substantial amount of solid oil. At most, it may have been "obvious to try" Nakashima's methods on JP '529's emulsions to see if such methods would yield an acceptable, stable, monodispersed composition. However, merely because such a combination may have been "obvious to try" does not make it obvious to combine these references with the expectation that a stable emulsion containing monodispersed globules would be obtained.

For this reason alone, the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

With respect to claims 39-41 and 43-45, these claims require that the claimed oily phase "consist essentially of" volatile oil, silicone oil and volatile silicone oil. Because JP '529 requires that a substantial amount of solid oil be present, these claimed compositions are distinguishable from JP '529.<sup>1</sup> These claims are directed to O/W emulsions containing oily

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<sup>1</sup> In this regard, Applicants note that the specification distinguishes between "oils" and "fatty substances" such as waxes or fatty alcohols. Here, "fatty substances" are similar to

phases which do not contain a substantial amount of fatty substances (such as waxes or solid oils), although it is to be understood that minimal amounts of such substances as well as oil-soluble ingredients (such as, for example, oil-soluble active agents and/or antioxidants) could be present as long as their presence does not materially affect the basic and novel properties of the claimed emulsion. Nakashima, which is virtually silent regarding oils, does not compensate for JP ‘529‘s deficiencies. Accordingly, no *prima facie* case of obviousness exists.

Claims 42 and 46 are similarly free of the cited art. These claims are directed to emulsions in the form of milks or creams: that is, these claims are directed to non-solid, easily-spammable compositions. Such compositions are in stark contrast to the solid, unusable composition obtained from JP ‘529. As noted in the Rule 132 declaration submitted with Applicants’ April 3, 2002 Amendment, JP ‘529‘s emulsions, which do not contain monodispersed oil globules, are extremely solid compositions which do not have a pleasant feel when applied to skin. In contrast, the claimed emulsions are creamier compositions which have pleasant application qualities, making such compositions much more desirable to consumers and, thus, a significant advance over JP ‘529‘s emulsions. Again, Nakashima, which is silent regarding product form, does not compensate for JP ‘529‘s deficiencies.

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JP ‘529‘s “solid oils.”

In view of the above, Applicants respectfully submit that the §103 rejection based upon JP '529 and Nakashima is improper and should be withdrawn.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

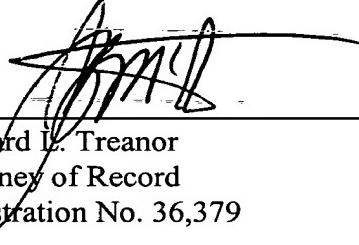
Respectfully submitted,

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Claims 39-46 (new)